

Remarks

This Preliminary Amendment is being filed in conjunction with a Request for Continued Examination (RCE) filed in the above-referenced patent application. This Preliminary Amendment is being submitted in response to the Final Office Action dated June 30, 2005. A request for a three-month extension of time is being filed concurrently with the RCE and this Preliminary Amendment, however if any additional fees are required, please consider this a request therefore, and authorization is hereby provided to charge any such fee or fees to Deposit Account No. 50-3703.

As a result of the Final Office Action dated June 30, 2005, claims 1-2 as amended were rejected, and claims 3-13 remained canceled. In this Preliminary Amendment, claims 1-2 are presented, and new claims 14-41 are presented herein. No new matter has been added.

Claim Rejections - § 103

In the Final Office Action dated June 30, 2005, the Examiner rejected claims 1-2 under 35 USC § 103(a) as being unpatentable over Busking et al. (6,107,684) in view of Tamura et al. (6,166,971) and Sheshita (6,366,770). Furthermore, the Examiner referenced the patent to Gonda (4,924,195) in the Examiner's arguments.

Contrary to the Examiner's assertion, none of the documents provided by the Examiner teaches or discloses:

... an integrated circuit having at least one circuit etched thereon, the circuit comprising elements which require theoretically negative reactive component values ...

... wherein the negative reactive component values are actually incorporated into the circuit through the use of wire bonds having pre-determined inductance values

as claimed in independent claim 1 and dependent claim 2. In particular, none of the cited documents teaches or discloses that "negative reactive component values are actually incorporated into the circuit through the use of wire bonds". Furthermore, none of the cited documents provides any suggestion or motivation to combine the teachings of

Busking with any of the teachings of Tamura, Sheshita, or Gonda to arrive at an integrated circuit package wherein "negative reactive component values are actually incorporated into the circuit through the use of wire bonds". The Examiner is kindly reminded that, in order to establish that a claim is *prima facie* obvious, three basic criteria must be met (see MPEP §§ 2142 and 2143):

1. The prior art reference (or references when combined) must teach or suggest all the claim limitations;
2. There must be some suggestion or motivation to modify the reference or to combine the reference teachings;
3. There must be a reasonable expectation of success.

In making an argument with respect to suggestion or motivation to combine, the Examiner stated:

This is because of the desirability to form an integrated circuit die of crystal oscillators that can be operated in the high frequency (HF) and ultra high frequency (UHF) band, and to serve as a buffer and impedance transformer between the low impedance output and the high impedance of a load, wherein using available wire bonds as an inductor element would save area for other devices, would reduce processing steps, and production costs.

The Assignee hereby respectfully traverses the Examiner's assertion of motivation, above. The Examiner is kindly reminded that:

The examiner bears the initial burden of factually supporting any conclusion of obviousness. MPEP § 2142. (Emphasis added).

The Examiner has not stated the source of the Examiner's assertion of motivation in the above quoted paragraph, nor has the Examiner otherwise provided any facts supporting the assertion of motivation. If the Examiner is basing the assertion of motivation on a particular document, the Examiner is hereby requested to cite the document and to particularly point out where in such document the basis for the assertion of motivation exists. If the Examiner is basing the assertion of motivation on his own personal knowledge, the Assignee hereby respectfully requests the Examiner set forth the

particular facts of his own personal knowledge in an Examiner's affidavit. See MPEP 2144.03 and 37 CFR 1.104(d)(2). If the Examiner cannot cite a document or is not able to set establish his own personal knowledge as the basis of the rejection, the rejection should be withdrawn. In other words, the Assignee is hereby requesting the Examiner to particularly point to the source of the suggestion or motivation to combine the provided documents, and if the Examiner cannot point to any such source, the rejection should be withdrawn as not being factually supported. MPEP §§ 2142, 2143. The Examiner is kindly reminded that:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. MPEP § 2143.01 (Emphasis added)

Furthermore, contrary to the Examiner's assertion, Seshita does not teach:

... wherein the theoretical values of the elements of the circuit required by the integrated circuit are actually incorporated into to the circuit through the use of wire bonds 20h, 20i, 20j ...

In fact, the Assignee has carefully reviewed the cited portion of Seshita (col 5, line 16 through col 6) and simply cannot find that this passage of Seshita supports the Examiner's assertion, above. Since the passage cited by the Examiner is nearly two fully columns, the Examiner is kindly invited to highlight with more particularity the sentences of Seshita that the Examiner feels supports the assertion, or to otherwise withdraw the rejection as not being factually supported by Seshita. MPEP § 2143.01

Furthermore, the Examiner has not satisfied the third element of establishing *prima facie* obviousness by not stating or factually establishing that the cited documents provide any expectation of a successful combination of the documents cited by the Examiner. Thus, without any factual support of the Examiner's assertion of the desirability of the cited combination, or of any motivation to arrive at such a combination, *prima facie* obviousness has not been established, so the rejection should be withdrawn.

Conclusion

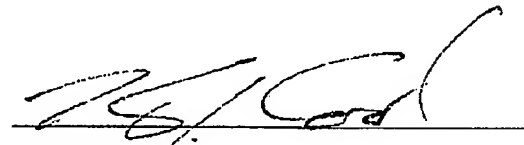
In light of the foregoing, reconsideration and allowance of all the pending claims is hereby earnestly requested.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, Kenneth J. Cool, at (720) 227-9445 if there remains any issue with allowance.

Respectfully submitted,
ATTORNEY FOR ASSIGNEE

Date: 12/30/05


Kenneth J. Cool
Reg. No. 40,570

Customer No. 43831